

REMARKS

Reconsideration and withdrawal of the rejections to the present claims are requested for the reasons set forth in the Amendment filed January 8, 2003, which is incorporated herein by this reference, and for the reasons set forth herein.

Claims 78-101 were pending in this application. By this Amendment, claims 102-105 have been added to further define Applicants' invention. Support for claims 102-105 is found in the specification on page 12, lines 3-10. No new matter has been added.

A check in the amount of \$36.00 for the four additional dependent claims in excess of 20 claims which were added by this Amendment is enclosed. No additional fees are believed necessary for entry and consideration of this Amendment. However, the Commissioner is hereby authorized to charge any fees or credit any overpayment to Deposit Account No. 50-0540.

I. Improper Final Rejection

Applicants respectfully submit that the finality of the Office Action is improper for the following reasons.

First, the Final Office Action includes a new ground of rejection not necessitated by amendment. More specifically, in the last Office Action, claims 78, 85, 86, 87, 88, 94, 95, 96 and 97 were rejected under 35 USC Section 102 over Blackburn. In the present Office Action, claims 78-97, 99 and 100 are rejected under 35 USC Section 102 over Blackburn. Thus, in the final Office Action, claims 79-84, 89-93 and 99 are newly rejected over Blackburn. None of these claims were amended in the previous response filed January 8, 2003. Thus, the finality of the Office Action is improper and should be withdrawn (MPEP 706.02(a)).

Second, with respect to the prior art rejections (See Section IV below), Applicants respectfully submit that the Final Office Action does not contain a response to Applicants' arguments regarding the prior art rejections set forth in the previous Amendment. Applicants urge that the failure to respond to each of Applicants' arguments is improper. "Piecemeal examination should be avoided as much as possible" (MPEP 707.07(g)). As also stated in the MPEP:

Before final rejection is in order a clear issue should be developed between the examiner and the applicant ... In making the final rejection, all outstanding grounds of rejection of record should be carefully reviewed, and any such grounds relied on in the final rejection should be reiterated. They must also be clearly developed to such an extent that applicant may readily judge the advisability of an appeal unless a single previous Office action contains a complete statement supporting the rejection. However, where a single previous Office action contains a complete statement of a ground of rejection, the final rejection may refer to such a statement **and also should include a rebuttal of any arguments raised in the applicant's reply.** (emphasis added)

MPEP 706.07.

Applicants respectfully request that the Examiner respond to the arguments as set forth in their previous Amendment and as set forth herein, in the next office action. Applicants most respectfully request the Examiner's cooperation in this regard.

Accordingly, Applicants submit that the finality of the pending office action is improper and should be withdrawn.

II. Restriction/Election

With respect to the Examiner's restriction of claim 101, Applicants respectfully submit that new method claim 101 is dependent upon method claim 98, which itself is dependent upon elected product claim 78. As set forth in the MPEP:

Where product and process claims drawn to independent and distinct inventions are presented in the same application, applicant may be called upon under 35 U.S.C. 121 to elect claims to either the product or process. See MPEP 806.05(f)

and 806.05(h). The claims to the nonelected invention will be withdrawn from further consideration under 37 CFR 1.142. See MPEP 809.02(c) and 821 through 821.03. **However, if applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined. (emphasis added)**

MPEP 821.04.

Accordingly, Applicants respectfully request that new claim 101 be rejoined with the elected product claims if the product claims are subsequently found allowable.

III. Oath/Declaration

In the previous Amendment, Applicants amended the specification to delete the claim to priority to U.S. Application Nos. 08/954,355 and 08/437,348. As a result of that amendment, the present application claims priority only to parent application serial no. 08/988,137, filed December 23, 1997, now U.S. Patent No. 6,319,670.

In the Final Office Action, the Examiner indicates that a “new oath or declaration is required because the applicant has amended the claim priority” (Office Action, page 3). It is unclear what the basis for the Examiner’s requirement that a new oath or declaration be submitted is since Applicants merely deleted a reference to prior U.S. applications, not foreign priority documents. As set forth in the MPEP:

Oaths and declarations must make reference to any foreign application for patent (or inventor's certificate) for which priority is claimed and any foreign application filed prior to the filing date of an application on which priority is claimed, unless such information is included in an application data sheet. See 37 CFR 1.63(c)(2).

MPEP 602.

Thus, contrary to the Examiner’s suggestion, a new oath or declaration does not appear to be required.

IV. The Inventive Subject Matter of the Present Claims are Not Unpatentable over the Cited References

Claims 78-97, 99 and 100 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Blackburn et al., Clin. Chem., Vol. 37, No. 9 (1991), pp. 1534-1539 (“*Blackburn*”). Claims 78, 85-88, 94-97 and 100 are rejected under 35 U.S.C. 102(b) as allegedly being anticipated by U.S. Patent No. 5,597,910 to Gudibande et al. (“*Gudibande*”). Claims 78-82, 84-97 and 99 are rejected under 35 U.S.C. 102(b) as allegedly being anticipated by U.S. Patent No. 5,679,519 to Oprandy et al. (“*Oprandy*”). Claims 83 and 100 is rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 4,372,745 to Mandle et al. (“*Mandle*”). Finally, claims 78-82, 85-91, 94-97 and 99 are rejected under 35 U.S.C. 103(a) as allegedly being obvious over PCT Patent Publication WO 90/05301 to Shah et al. (“*Shah*”). These rejections will be addressed collectively.

Applicants respectfully submit that the cited references do not render the presently claimed subject matter unpatentable for the reasons set forth in Applicant’s previous Amendment filed January 8, 2003, which is oncoporated herein by this reference.

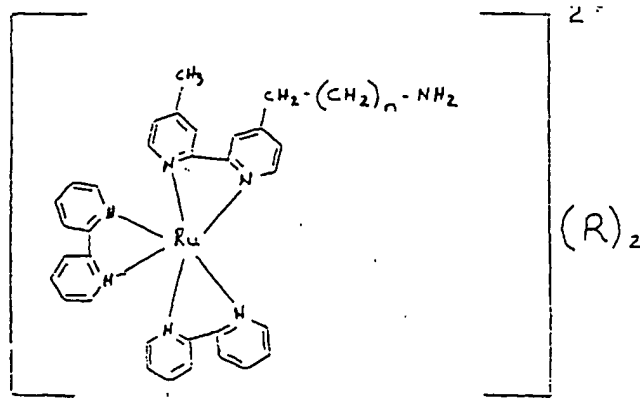
In the Final Office Action, the Examiner merely states:

The response states that Ru surrounded by bipyridyl groups does not support a 102 rejection. The term metal containing reads broadly and would read on the prior art of Blackburn et al, Gudibande et al and Oprande et al and Mandle et al and Shah et al each individually. The rejections are maintained.

Final Office Action at page 5.

Applicants submit that the above assertions do not support the pending rejections and do not address the arguments presented by Applicants in their previous response. The claims do not merely recite “metal containing” as suggested in the Final Office Action.

More specifically, claim 78 recites “**A microparticle comprising a core and electrochemiluminescent moieties within said core.**” Each of the cited references merely discloses electrochemiluminescent complexes. The following depicts a typical electrochemiluminescent complex (similar to the complexes of the cited references).



The above figure shows an Ru metal surrounded by bipyridyl groups forming a complex. One of ordinary skill in the art would not interpret claim 78, for example, to read on an electrochemiluminescent complex. The fact that such complexes comprise a Ru metal surrounded by several bipyridyl groups does not support the Examiner’s assertion that the labels anticipate the presently claimed subject matter. More specifically, the electrochemiluminescent complexes **are not microparticles having a core with electrochemiluminescent labels within the core**. The “Ru” metal within the electrochemiluminescent complex of the cited references, for example, is not itself an electrochemiluminescent label, but is instead a mere part of a label.

Thus, it is unclear how the Examiner’s assertion that “the term metal containing reads broadly” would support the rejections. The claims clearly relate to microparticles having cores

and electrochemiluminescent labels (such as those labels disclosed in the cited references) within the core.

Also, with respect to new claims 102-104, the electrochemiluminescent complexes described in the cited references would not have the diameter sizes set forth in the claims.

With respect to *Mandle*, Applicants respectfully submit that *Mandle* also does not disclose the presently claimed subject matter. In the Final Office Action, the Examiner asserts that *Mandle* teaches “that electrochemiluminescent particles are enclosed within a liposome”, but then continues by describing *Mandle*’s disclosure relating to fluorescer labels. Applicants respectfully submit that *Mandle* does not in any way relate to incorporating metal-containing electrochemiluminescent labels within microparticles. Rather, *Mandle* merely discloses a microencapsulated fluorescent material. Applicants submit that methods involving the measurement of fluorescence from fluorescent labels in a liposome would not make electrochemiluminescence measurements obvious. The fluorescence measurements use light to excite the labels; electrochemiluminescence involves the electrochemical excitation of the labels at or near an electrode. Thus, one of ordinary skill in the art would not have had a reasonable expectation of success with respect to modifying *Mandle* to use electrochemiluminescent labels in place of fluorescent labels. Therefore, *Mandle* does not render the presently claimed subject matter unpatentable.

Accordingly, Applicants respectfully submit that each of the above-cited rejections, whether under 35 U.S.C. Section 102 or under 35 U.S.C. Section 103, are improper and should be withdrawn.

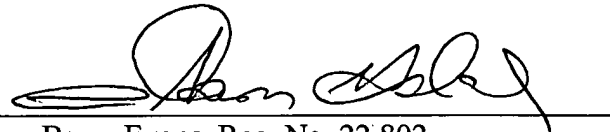
V. Conclusion

In view of the arguments, comments and remarks provided herein, withdrawal of the rejections to Claims 78-100 pending in this application is earnestly solicited, together with favorable reconsideration of the application and prompt issuance of a Notice of Allowance.

Additionally, if the Examiner believes that there are any issues still pending which present an impediment to allowance, it is respectfully requested that the undersigned be contacted by telephone and be afforded the opportunity to conduct a telephonic interview.

Respectfully submitted,

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